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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,270	05/02/2001	Palpu Pushpangadan	056859-0126	6119

22428 7590 05/06/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 05/06/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/846,270

Applicant(s)

PUSHPANGADAN ET AL.

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears n the cover sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 71-119 is/are pending in the application.
- 4a) Of the above claim(s) 82,104-106 and 108-114 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 71-81, 83-103, 107, 115-119 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 71-119 are pending. Claims 82, 104-106, 108-114 are withdrawn from consideration, as they are directed toward non-elected subject matter.

Response to Arguments

Applicant has provided no arguments toward the combination of references in the instant and previous rejection. Thus, the Examiner has no arguments to respond to.

The Applicant's amendment filed 3/17/03, Paper No. 11, which cancelled all the previously pending claims, is sufficient to overcome the 35 USC 112 rejection in the previous Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 90 and 100 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase "in the range of traces to ppm" in claims 90, 100 is vague and indefinite, as the metes and bounds of these claims are unascertainable. Quantitatively, what is traces? Is ppm, 1ppm-1,000,000ppm?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 71-81, 83-100, 103, 107, 115-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz (2002/0082279) in view of Tu (CN 1113773).

The instant invention is directed toward a composition comprising an herbal colourant selected from the general of the family Boraginaceae and an additive selected from essential oils/aroma isolates selected from a group of plant species.

Schultz teaches a composition for the treatment of dermatologic diseases comprising an active agent, essential oils, and a carrier. The composition is taught as treating acne, dermatitis, wrinkles and other disorders. Citronella (synonym for cymbopogon nardus), basil (synonym for ocimum basilicum), and jasmine are disclosed as essential oils with direct skin effects for use in his composition. The essential oils are further taught as moisturizing the skin. See [0003]-[0019]. The reference lacks macrotomia and preferred percent weights.

Tu teaches a cosmetic composition comprising natural plant extracts for the treatment of acne, folliculitis, dermatitis, and wrinkles. Arnebia (synonym for Macrotomia) is taught as a plant extract. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the Macrotomia taught by Tu into the composition of Schultz because of the expectation of achieving a composition that potently treats acne and because it is obvious to combine two compositions taught by the prior art to be useful for the same purpose to form a third composition that is to be used for the very same purpose. In re Kerkoven, 205 USPQ 1069 (CCPA 1980).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the amounts of the active ingredients in the combined references because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 101-102 rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz in view of Tu as applied to claims 71-81, 83-100, 103, 107, 115-119 above, and further in view of Benford (5,110,593).

Schulz and Tu are applied as discussed above. The references do not teach beeswax.

Benford teaches a composition for treating dermatitis, such as acne. Beeswax is disclosed as the carrier. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the carrier of the combined references as beeswax because a) the combined references teach a composition for treating acne and Benford teaches beeswax as a carrier for use in topical compositions for treatment of acne; and b) because of the expectation of achieving a composition wherein the base is topically safe and does not further aggravate acne.

The Examiner respectfully points out a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA

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1963). In the instant case the intended use of the composition claims have not been afforded patentable weight.

It is further respectfully pointed out that many claims are directed to the properties of a compound. The Examiner respectfully points out that a compound and its properties are inseparable (In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for

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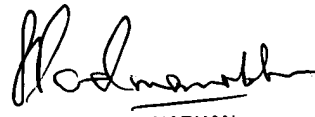
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the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
April 28, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER

5/4/03